UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,303	06/23/2000	Scott Lorenz	5053-36000	1772

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EXAMINER
BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 March 2004_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-11,13-18 and 20-22_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-11,13-18 and 20-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _17_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendment filed 24 March 2004.

Claims 1-11, 13-18, and 20-22 are pending. Claims 1, 9, and 16 have been amended.

The IDS statement filed 27 October 2003 has been entered and considered.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-2, 5-11, 13-18, and 20-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Borghesi et al. (5,950,169) in view of DeFrancesco, Jr. et al.

(6,505,176).

(A) As per claim 1, Borghesi discloses a system for managing insurance claim

processing comprising:

(a) a communication server for insurance claim management comprising a

processor coupled to memory, wherein the memory is embodied as a mass storage

device and storing a program constructed using known software tools and languages,

wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

transmitting, from a remote computer, a predetermined amount of data related to calculating a total loss valuation to the server, wherein the predetermined amount of data is input by a user through a user interface, wherein the total loss valuation is then sent back to the remote computer (Figure 1, 7, col. 21 lines 29-35 and col. 23 lines 17-34);

(b) at least one remote computer terminal comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

inputting and outputting data pertaining to an insurance claim through a graphical user interface (col. 23 lines 17-34); and

sending an insurance claim data file over a network to the communication server, wherein the data file contains data on the insured, data on a claim, and data on satisfying a claim (col. 20 line 55 to col. 21 line 17 and col. 22 lines 19-40).

Borghesi fails to expressly disclose a sequence of insurance claim processing steps executable to complete an insurance claim processing task, **wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time** and

wherein a second set of program instructions comprises a sequence of steps established dynamically in real time.

DeFrancesco discloses a method for dynamically managing workflow for an automated application system in response to functions executed by a user or by the automated application system comprising the step of processing a workflow for an application by identifying an executed function, wherein said executed function can be executed by the user or by the automated application system, finding a set of potentially affected workflow process steps comprising all workflow process steps associated with said executed function, calculating the status of each workflow process step in said set of potentially affected workflow process steps, **dynamically determining, in response to said identifying steps, said finding step, and said calculating step, a next step for each said workflow process step** (col. 16 line 58 to col. 17 line 28, col. 18 lines 58-60). Further, DeFrancesco discloses an example of the "dynamically determining steps" comprising saving information and then updating several database elements, wherein the two database elements include "primary income" and "secondary income". An associated rule element "total income" is derived from the database elements of primary and secondary income, wherein the rule element is derived as follows: "total income=primary income + secondary income". Next, a test associated with the total income rule element is created called the "verify" test, wherein the verify test is true if the total income is greater than $20,000, wherein a process step exists that requires an applicant's income to be verified only if the verify test is true, and if the verify test is false, the process step is skipped. Therefore, using this example, the user action of

inputting and saving an applicant's income to the database, causes the verify test to be

evaluated. If the test is true, the process step becomes an active step in the workflow.

If the test is false, the process step is skipped. The appropriate workgroup queues are

updated to include the process step only if the verify test is true (col. 6 line 65 to col. 7

line 60). Further, DeFrancesco discloses that the steps may be executed in any order

and the steps are executed using a dynamic module of a computer system having

instructions loaded upon it and connected to workstations having instructions over a

network (col. 4 line 61 to col. 5 line 23, col. 5 lines 46-65, col. 8 line 22 to col. 9 line 23,

col. 9 lines 52-64, col. 15 line 30 to col. 16 line 47).

At the time the invention was made, it would have been obvious to one of

ordinary skill in the art to combine the teachings of DeFrancesco within the method of

Borghesi with the motivation of allowing steps within a process and the order in which

these steps are processed to vary (DeFrancesco; col. 2 lines 3-12) thus reducing the

cycle time for development and testing of software and reducing the costs in developing

software (DeFrancesco; col. 2 lines 12-24).

(B) As per claim 2, Borghesi discloses the insurance claim data file comprising data

gathered concerning the extent of damage or injury suffered by the insured, insurance

claim settlement information including data on satisfying a claim such as estimates and

a total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines 5-15, col. 22 lines 54-

63, and col. 23 lines 4-16).

(C) As per claim 5, 11, and 18, DeFrancesco discloses a network such as the Internet

(col. 4 lines 40-60).

Borghesi and DeFrancesco do not expressly disclose the Internet protocols being

HTTP. However, when communicating information from a server to a browser over the

Internet, the protocol almost universally used is HTTP, and the skilled artisan would

have found it an obvious modification to include communicating using the Internet and

HTTP within the system taught by Borghesi and DeFrancesco with the motivation of

increasing the ease of access to information and calculations from a remote computer

(Borghesi; Fig. 3 and col. 10 lines 28-45) including reducing the time to access

information.

(D) As per claim 6, Borghesi discloses the server and remote computer terminals

format and send data over a network using TCP/IP (Fig. 2 and col. 11 lines 44-52).

(E) As per claim 7, Borghesi discloses at least one remote computer and a network

connecting the computers to a server (Fig. 2 and col. 20 lines 33-50). The remainder of

claim 7 repeats the same limitations of claim 1, specifically with regards to the steps

performed using the apparatus of claims 1, and therefore claim 7 is rejected for the

same reasons given above for claim 1, and incorporated herein.

(F) As per claims 8, 15, and 22, Borghesi discloses an insurance claim data file

comprising data gathered concerning the extent of damage or injury suffered by the

insured, insurance claim settlement information including data on satisfying a claim

such as estimates and a total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines

5-15, col. 22 lines 54-63, and col. 23 lines 4-16). Borghesi also includes repairing the

damaged object (col. 15 lines 64 to col. 16 lines 22). Borghesi fails to expressly

disclose the one or more treatments of bodily injuries. However, it is respectfully

considered that repairing a damaged object is considered a form of treatment to fix the

damaged object. The skilled artisan would have found it an obvious modification to

include treatments of bodily injury within the system taught collectively by Borghesi and

DeFrancesco with the motivation of efficiently managing an insurance claim workflow by

performing, evaluating, and documenting all tasks when processing a claim (Borghesi;

col. 2 lines 20-30).

(G) Method claims 9-10 and 13-14 repeat the subject matter of system claims 1-2 and

6, respectively, as a series of steps rather than as a set of apparatus elements. As the

underlying apparatus elements of claims 1-2 and 6 have been shown to be fully

disclosed by the collective teachings of Borghesi and DeFrancesco in the above

rejections of claims 1-2 and 6, it is readily apparent that the method disclosed

collectively by Borghesi and DeFrancesco includes the steps performed by the

apparatus. As such, these limitations are rejected for the same reasons given above for

method claims 1-2 and 6, and incorporated herein.

(H) Claims 16-17 and 20-21 repeat the subject matter of system claims 1-2 and 6, respectively, as a carrier medium comprising computer instructions to carry out the functionality of the system from method claims 1-2 and 6. As the underlying apparatus elements of claims 1-2 and 6 have been shown to be fully disclosed by the collective teachings of Borghesi and DeFrancesco in the above rejections of claims 1-2 and 6, it is readily apparent that the programs embodied in a mass storage device or memory of a computer (Borghesi; col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50) disclosed by the collective teachings of Borghesi and DeFrancesco provides the means to carry out the functions of the system. As such, these limitations are rejected for the same reasons given above for method claims 1-2 and 6, and incorporated herein.

4.   Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al. (5,950,169) and DeFrancesco, Jr. et al. (6,505,176) as applied to claim 1, and further in view of Aquila et al. (US 2002/0035488 A1).

(A) As per claim 3, DeFrancesco discloses a rules module comprising a plurality of rule elements, each of said rule elements associated with one or more of the database elements, and each of said rule elements associated with one or more tests (col. 18 lines 32-42).

Borghesi and DeFrancesco fail to expressly disclose a rules engine and web browser.

Aquila discloses utilizing business rules and a rules engine in a system for insurance claims processing (Abstract; par. 129) and client software being a web browser (par. 91).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Aquila within the method taught collectively by Borghesi and DeFrancesco with the motivation of increasing the flexibility of an insurance claim capture system by not forcing claimants to fill out standardized questions in standardized formats that often do not fit their needs (Aquila; par. 8).

(B) As per claim 4, Aquila discloses capturing first notice of loss(FNOL) at a first notice of loss system on the server through the consumer using client software, wherein the FNOL validates the insurance policy under which the claim is being asserted, presents the user with tailored questions, where the presentation format varies depending on the type of user, wherein questions subsequent to certain gateway questions presented to the user vary according to the user's answers to gateway questions, wherein the user then fills out and submits answers to the questions with which he is presented, wherein the FNOL determines if the submitted questionnaire is complete and the answers submitted valid, and creates a new claim record for that claim, wherein the claim data captured can be transmitted to and stored in the e-claim database or insurance carrier system (Fig. 1-4, par. 91, 100-102, 111). Aquila also discloses the client software being a web browser wherein responses from the server are built in XML and HTML (par. 97

and 91). Viewing data in a web browser using XML and HTML is considered to be a

form of Applicant's "web page".

The motivation for combining Aquila within Borghesi and DeFrancesco is given

above in claim 3, and incorporated herein.

Response to Arguments

5.   Applicant's arguments with respect to claims 1, 3-4, 9, and 16 have been

considered but are moot in view of the new ground(s) of rejection.

6.   Applicant's arguments filed 23 March 2004 have been fully considered but they

are not persuasive. Applicant's arguments will be addressed below in the order in

which they appear in the response filed 23 March 2004.

(A) At page 11 of the response filed 23 March 2004, Applicant argues that Borghesi

does not disclose the features of claim 2.

In response, the Examiner respectfully submits that Borghesi clearly discloses

the insurance claim data file comprising data gathered concerning the extent of damage

or injury suffered by the insured, insurance claim settlement information including data

on satisfying a claim such as estimates and a total loss calculation for a claim (col. 2

lines 50-59, col. 5 lines 5-15, col. 22 lines 54-63, and col. 23 lines 4-16). Thus, based

on the teachings of the prior art, the rejection is maintained.

(B) At page 12 of the response filed 23 March 2004, Applicant argues that the applied

prior art fails to teach the features of claim 8.

In response, the Examiner respectfully notes that neither of the Borghesi and

DeFrancesco references were ever applied as references under 35 U.S.C. 102 against

the pending claims. As such, the Examiner respectfully submits that the issue at hand

is not whether the applied prior art specifically teaches the claimed features, *per se*, but

rather, whether or not the prior art, <u>when taken in combination with the knowledge of

average skill in the art</u>, would put the artisan in possession of these features.

Regarding this issue, it is well established that references are evaluated by what they

suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*,

163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the

references expressly state but by what they would reasonably suggest to one of

ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160

USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071,

1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223

USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*,

192 USPQ 278 (CCPA) that:

(i)   obviousness does not require absolute predictability;

(ii)   non-preferred embodiments of prior art must also be considered; and

(iii)   the question is not express teaching of references, but what they would

suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references.   In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In this case, each limitation recited in claim 8 has been addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Evans based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as clearly detailed in the remarks and explanations given above, and incorporated herein.

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure. The cited but not applied prior art teaches attachment integrated

claims system and method (6,199,115).

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm,

and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Receptionist whose telephone number is (703)

306-1113.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

10.   **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326   [Official communications]

(703) 872-9327   [After Final communications labeled "Box AF"]

(703) 746-8374   [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB

June 7, 2004

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